

REMARKS

Office action summary. Claims 1-9 and 21-62 are under consideration.

There is an objection to the specification as failing to provide antecedent basis for claims 45, 52, and 60. Claim 29 is objected to as being in improper dependent form. Claims 2, 6-8, and 27-30 are rejected as indefinite.

Claims 41, 43, 44, 47, 50, 51, 56, 58 and 59 are rejected as anticipated by Netsch et al. (USPN 6,364,993). Claim 55 is rejected as obvious over Netsch et al. in view of Lee (USPN 5,163,846). Claims 45, 46, 52-54, and 60-62 are rejected as obvious over Netsch et al.

Claims 47 and 49-55 are rejected for obviousness-type double patenting over claims 32 and 34-40 of U.S. Patent No. 6,723,383. Claims 1-9 and 21-62 are rejected for obviousness-type double patenting over claims 60, 62, 68-70, 80-91, 84, and 90-111 of copending Application No. 10/314,855, which has now matured into U.S. Patent No. 6,936,316.

The above rejections are obviated by the amendments made in this response, and otherwise traversed.

Applicant thanks the Examiner for reconsidering and withdrawing the restriction requirement.

Antecedent basis in specification. The Examiner has found that “Claims 45, 52 and 60 recite that the reflective surface is holographic however the specification fails to provide proper antecedent basis for a holographic surface.” (Office action at 2.) The specification has been amended to add a sentence referring to holographic surfaces. This sentence does not add new matter because it conforms the specification to the claims. The possibility of using a holographic surface was recited in the originally filed claims of the parent application 09/812,712.

Objection to claim 29. The objection to claim 29 has been obviated by amendment to that claim. The amendment is supported by paragraph 66 of the application.

Indefiniteness rejections. The Examiner finds claim 2 indefinite on account of the use of the word “metallic-looking.” The invention at hand has as a major application the production of surfaces having a particular desired appearance. In practice, the appearance of such surfaces would be evaluated by an industrial designer or similar person who would determine whether the appearance of the surfaces is appropriate for the intended application. A metallic appearance would be a part of this evaluation if in the designer’s view such an appearance is desired. This is similar, for example, to the way a painted surface for an automobile exterior panel would be

evaluated by an automobile designer. In this field, the use of quantitative terms such as "matte," "glossy," or "metallic-looking" is normal and is understood by the persons who are designing goods for which surfaces of those characteristics are desired. For this reason, it is believed that the term "metallic-looking" is not indefinite and adequately apprises the public of the metes and bounds of the invention as claimed.

The Examiner finds claims 6-8 indefinite on account of errors in the formulas (I) and (II) in claim 6. These errors have been corrected by amendment. Support for the amendment is found in paragraphs 55 and 58 of the application.

The antecedent basis problems pointed out by the Examiner in claims 27-30 have also been corrected by amendment. Support for the amendment to claim 27 is found in paragraphs 52 and 53 of the application.

Rejections over Netsch. Claims 41, 43, 44, 47, 50, 51, 56, 58 and 59 are rejected as anticipated by Netsch et al. (USPN 6,364,993). Claim 41 reads as follows:

41. A substrate having a glossy, reflective, and/or luminescent surface coated with an opaque coating composition that becomes partially or entirely transparent upon contact with a recording liquid.

The Examiner's position is that the "recording liquid" can read on the water in Netsch. However, "recording liquid" has an express definition at paragraph 27 which requires an ink, gel, ink-gel, or solution. Water itself would not seem to qualify as any of these things, although the recording liquid could be an aqueous solution comprising water plus a solute. Claims 47 and 56 likewise recite a recording liquid and are not anticipated by Netsch for the same reason. The remaining claims rejected as anticipated depend on 41, 47, or 56, and so are not anticipated.

Furthermore, the Examiner states that the recital of paper, metal, plastic, and glass substrates in Netsch "encompasses" glossy and reflective. However, the substrates of Netsch serve as carriers for an image (col. 3, lines 14-25). It is the image which provides the surface appearance in Netsch, not the underlying substrate. Furthermore, a disclosure which "encompasses" a limitation X is not generally sufficient to anticipate a claim requiring X. *See, e.g., Finnigan v. United States Int'l Trade Comm'n*, 180 F.3d 1354, 1366 (Fed. Cir. 1999) (where a prior art reference contains a figure which "might disclose a set-up for performing either resonance or nonresonance ejection," it does not inherently disclose either of those two things).

Netsch does not specifically disclose that the images on the surface of its substrates are glossy, reflective and/or luminescent. Without such disclosure, there is no anticipation by Netsch.

Claims 45, 46, 52-54, and 60-62 are rejected as obvious over Netsch. The Examiner's major argument for obviousness appears to be that if Netsch teaches paper, metal, and plastic substrates, then laminates of those materials and holographic surfaces are obvious. The Examiner does not indicate a reason why a person of skill would be motivated to modify the teachings of Netsch, as required for an obviousness rejection over a single reference. *See, e.g., Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997) ("World has shown no suggestion or motivation to modify the teaching of the '789 patent with regard to non-metallic fibers. Hence, it failed to prove that the invention would have been obvious in light of the '789 patent."). Instead, the Examiner simply states that "it would have been obvious to one having ordinary skill in the art at the time of the invention to provide *any design or decorative pattern*, wherein a holographic design is an *obvious species of decorative designs* having a metallic surface or appearance." (Emphasis added.)

The Examiner's reasoning is based on a misunderstanding of obviousness. To find obviousness of a claim reciting a limitation X not met by a prior art reference, there must be clear and particular suggestion or motivation to modify the disclosure of the prior art reference to meet limitation X. *See Kolmes, supra; In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999). It is not enough that the prior art reference discloses a broad class of things, where some of those things meet limitation X. That is especially so if the class disclosed is as broad as "any design or decorative pattern." Furthermore, to be an "obvious species" of a broad class, there must be something what would suggest to or motivate one of skill in the art to pick *that* species, rather any of the many other species which a broad general disclosure encompasses. *See, e.g., In re Baird*, 16 F.3d 380 (Fed. Cir. 1994) (holding that a disclosure of a genus containing millions of chemical compounds does not render obvious every compound within it).

In addition, because Netsch does not disclose the recited "recording liquid," the indicated modification of Netsch to use laminated substrates or holographic surfaces still does not bring its disclosure within what is claimed in the claims which the Examiner has rejected as obvious over Netsch.

Claim 55 is rejected as obvious over Netsch in view of Lee (USPN 5,163,846). Claim 55 depends on claim 47, which the Examiner has not shown to be obvious for the reasons set out above. Claim 55 has therefore not been shown to be obvious, at a minimum for that reason.

Obviousness-type double patenting rejections. When the remaining issues in the application are resolved, applicant expects to file a terminal disclaimer to overcome the obviousness type double patenting rejections over the parent and over U.S. Patent No. 6,936,316.

Applicant also notes that, under *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991), an obviousness-type double patenting rejection requires a showing that the claims of the 6,936,316 patent are obvious over those of the present patent as well as vice versa. See MPEP § 804 (discussing *Braat*). The assignee applied for the 6,936,316 patent after it applied for the parent of the present application, with a disclosure which encompasses further development in the general field of the invention. Most of the claims of the present application could not have been presented in the parent due to a restriction requirement. Thus, it is not applicants' fault that the 6,936,316 patent issued before the claims of the present application, and the two-way test of *Braat* applies.

Conclusion. For the reasons stated above, the claims as currently amended are allowable. If the Examiner would like to discuss the claims, please call the undersigned at (650) 251-7712 or e-mail at rose@reedpatent.com.

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